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In re application of :
Kwon et al. : DECISION ON
Serial No. 10/724,219 : PETITION
Filed: December 1, 2003 :
For: TAPE SUBSTRATE AND METHOD FOR FABRICATING THE SAME

This is a decision on the PETITION UNDER 37 CFR 1.144 TO WITHDRAW THE RESTRICTION REQUIREMENT IN THE OFFICE ICE ACTION mailed September 28, 2004.

On September 28, 2004, a restriction requirement was made by the examiner. The group of claims as set forth in the requirement were directed to a substrate and a method of making same. Applicants traversed the restriction requirement in a response filed October 28, 2004. The examiner maintained the requirement in an office action mailed January 10, 2005. Applicants again traversed the requirement in a response filed on May 9, 2005 and the examiner again maintained the restriction requirement in an office action mailed August 1, 2005.

On March 7, 2002, the instant petition under 37 CFR 1.144 was filed to formally request the withdrawal of the restriction requirement.

Applicant's position for the withdrawal of the restriction requirement is that the examiner has not shown that the separate groups are distinct.

DECISION

Sections 803 and 806.05(f) of the MPEP state in part:

803 [R-3] Restriction — When Proper

Under the statute, the claims of an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent or distinct.

If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.

806.05(f) [R-3] Process of Making and Product Made

A process of making and a product made by the process can be shown to be distinct inventions if either or both of the following can be shown: (A) that the process as claimed is not an obvious process of making the product and the process as claimed

can be used to make another materially different product; or (B) that the product as claimed can be made by another materially different process.

Allegations of different processes or products need not be documented.

If applicant convincingly traverses the requirement, the burden shifts to the examiner to document a viable alternative process or product, or withdraw the requirement.

In the restriction requirement mailed on September 28, 2004, the examiner required restriction between a tape substrate and a method of producing a tape substrate. The examiner took the position that the inventions are distinct because the product as claimed could be made by a different process and that the process could be used to make a different product.

In the responses filed October 28, 2004 and May 9, 2005, applicants argued that the examples cited by the examiner to show distinctness fail to meet the burden required for such a showing. It was argued specifically that the example put forth by the examiner regarding a different method of producing the instantly claimed product would not in fact produce that same product.

In all responses to the traversal of the restriction requirement, the examiner has failed to specifically address any of the arguments set forth by Applicant. Instead, she merely stated that there would be a burden to search to examine all of the claims and/or the claims may be rejoined at a later time if the product is found to be allowable. Applicant has shifted the burden back to the examiner to show that the two different groups are distinct. The examiner has not met this burden.

Because the examiner has not shown that the groups of claims are distinct, the restriction requirement is not proper. Accordingly, the petition for withdrawal of the restriction requirement is **GRANTED**.

It is noted that applicants have filed a response to the office action mailed August 1, 2005 and that the examiner has prepared a new non-final office action which was mailed on January 26, 2006. In view of this decision, the application is being forwarded to the examiner to prepare a new non-final office action which includes examination and action on the merits of all the claims previously withdrawn from consideration due to the restriction requirement.

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